REMARKS

Claims 9, 11 through 15, 21, 23 through 26, 29, 39 through 41, 47 through 49 and 52 through 75 are pending in this Application.   Claims 9, 11, 21, 29, 39 though 41, 52 through 54, 61, 62, and 67 through 74 have been amended, and a new claim 75 has been added. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, Abstract, [0009] and [0029] of the corresponding US Pub. No. 2003/0061624. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 9, 11 through 15, 21, 23 through 26, 29, 39 through 41, 47 through 49, and 52 through 74 were rejected as obvious under 35 U.S.C. §103(a) based on *McGarrahan et al. ("McGarrahan")* in view of *McGowan et al. ("McGowan")*.

In stating the rejection, the Examiner asserted that one having ordinary skill in the art would have been led to modify the content delivery system of *McGarrahan* that requires a multimedia bridge, by including the set-top box of *McGowan*, by providing a user interface for selecting the stored primary program data (after storing the primary program data and the associated secondary program data), and then retrieving said secondary program data for display, in order to distribute primary and secondary programming to multiple viewers.   Applicant respectfully traverses this rejection.

There are fundamental differences between the claimed inventions and the applied prior art that undermine the obviousness conclusion under 35 U.S.C. §103(a). Specifically, independent claims 9, 21, and 29 recite, *inter alia*, "running, **at the apparatus,** a software application so as to identify and copy one or more earmarked portions of the stored primary

program data **that are identified by a broadcaster within the stored primary program,** **creating and** storing**, at the apparatus,** a copy of the earmarked portions as an associated secondary program data file on the storage medium, wherein the primary program data and the secondary program data are stored in separate files." Independent claims 54, 61 and 68 recite, *inter alia*, "receiving, **at an apparatus,** primary program data comprising a multimedia broadcast program, said primary program data further comprising earmarking data identifying a plurality of earmarked portions of the multimedia broadcast program **as identified by a broadcaster within the multimedia broadcast program**; based on the earmarking data, copying the plurality of earmarked portions of the multimedia broadcast program to **create** a second data file **and store the second data file** separately from the first data file **at the apparatus**." None of these features are disclosed or remotely suggested by the applied prior art.

Applicants stress that the claimed inventions transmit only a primary program (e.g., a movie), and then produces a secondary program (e.g., a preview of the movie, i.e., a reduced copy of the movie) at an apparatus (i.e., a set-top box 1; [0029]), from earmarked portions of the primary program data stored at the apparatus that are identified by a **broadcaster** (e.g., a person, company, or organization) **within** the stored primary program. For example, the claim inventions reduce the transmission traffic by sending to the user receiver only the movie (without its preview), then creates the preview at the user receiver.

In contrast, *McGarrahan* creates a preview from a movie **before** the content transmission, ("*contents (e.g., movies, MP3, video games, local advertisements, previews, etc.*" [0038]). The preview and the movie are then multiplexed into the same data stream during transmission to a user receiver. In other words, the content of the preview are included in both of the preview and

the movie during transmission to the user receiver. Therefore, the shared contents were transmitted in two versions (on the preview and in the movie) redundantly in the same data stream to the user receiver and increase the transmission traffic.

In this case, since there are already two sets of the preview content in the data stream, *McGarrahan* only discloses a system to identify and "grab" (**but not to "copy"**) any tagged portions of the data stream. Therefore, contrary to the Examiner's assertion, *McGarrahan* does not disclose or suggest "running, at the apparatus, a software application so as to identify and **copy** one or more earmarked portions of the stored primary program data" as recited in the independent claims.

The "preview option" in *McGarrahan* includes only previews of films not yet released ([0028]), rather than any already released **primary program** received at a user receiver to be viewed thereat.   *McGarrahan* does not disclose that the preview is the preview of the movie in the same data stream. Since *McGarrahan* also places suitable advertisements and/or trailers as `pop-up` whenever a movie/game is paused, or at the end of the movie/game, such advertisements and/or trailers correspond to other movies ([0048]), rather than corresponding to the **primary program** as recited in the independent claims. There is simply no reason to play the preview of the same movie during the movie or at the end of the movie in *McGarrahan*, since the user already ordered and paid for the movie.

On the other hand, the claimed inventions identify and **copy** one or more earmarked portions of the stored primary program data, and then **create** and store, at the apparatus, a copy of the earmarked portions as an associated secondary program data file. The second program of the claimed inventions contains portions of the first program, rather than any suitable advertisements and/or trailers of other programs selected based upon user's viewing habits as in *McGarrahan*.

Moreover, *McGarrahan* tags portions in or onto data stream by a **remultiplexer** (i.e., a device) based upon **configurations** set by communication servicer providers or remultiplexer manufacturers ([0038]), rather than by a **broadcaster** (i.e., a person or organization) based upon **data content**. Therefore, *McGarrahan* neither discloses nor suggests "identifying and copying one or more earmarked portions of the stored primary program data **that are identified by a broadcaster** within the stored primary program" as recited in the independent claims.

The Examiner also asserted that the CD reader or CD jukebox in *McGarrahan* **replaces** at least a portion of audio data in the secondary program data with audio data from tertiary program data received from the communication channel as recited in claim 23. However, the CD reader or CD jukebox mentioned in [0086] in *McGarrahan* merely **plays** transmitted secondary program contents (e.g. a preview), but does not to "**substitute/replace**" contents in the preview.

Clearly, *McGarrahan* does not allow the user receiver to "run a software application so as to identify and copy one or more earmarked portions of the stored primary program data **that are identified by a broadcaster within the stored primary program**, and to **create and** store a copy of the earmarked portions as an associated secondary program data file on the storage medium, wherein the primary program data and the secondary program data are stored in separate files", as recited in the claimed inventions.

The secondary reference to *McGowan* does not cure the previously argued deficiencies in *McGarrahan*. *McGowan* is relied upon to teach a wireless communication link having characteristics suitable for sharing desired content. Thus, the applied references, whether taken alone or in combination, and Applicant certainly does not agree that the requisite realistic motivation has been established for combining the applied references, fail to engender a *prime facie* case of obviousness of the claimed subject matter. *Uniroyal, Inc. v. Rudkin-Wiley Corp.,*

837 F.2d 1044 (Fed. Cir.1988). Applicant, therefore, submits that the imposed rejection of claims 9, 11 through 15, 21, 23 through 26, 29, 39 through 41, 47 through 49 and 52 through 74 under 35 U.S.C. §103(a) for obviousness predicated upon *McGarrahan* in view of *McGowan* is not factually or legally viable and, hence, solicits withdrawal thereof.

New Claim 75.

New claim 75 depends from claim 21 and, hence, is free of the applied prior art for reasons advocated *supra* with respect to claim 25.   Further, the separate patentability of claim 75 is arguer based on the limitations expressed therein. Specifically, claim 75 recites that the earmarked portions of the stored primary program data are identified by the broadcaster based upon **data content**. This feature is not disclosed or suggested by *McGarrahan*.   As discussed, the **remultiplexer** in *McGarrahan* tags based upon **configurations** set by communication servicer providers or the remultiplexer manufacturer, rather than based upon **data content** identified by a broadcaster.   Accordingly, claim 75 is free of the applied prior art.

Based upon the foregoing, it is apparent that the imposed rejection has been overcome, and that all pending claims are in condition for allowance. Favorable consideration is therefore solicited. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at 703-519-9954 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is

hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

including extension of time fees, to Deposit Account 504213 and please credit any excess fees to

such deposit account.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

September 29, 2009   /Arthur J. Steiner/
Date   Arthur J. Steiner
                                         Attorney/Agent for Applicant(s)
                                         Reg. No. 26106

                                         Chih-Hsin Teng
                                         Attorney for Applicant(s)
                                         Reg. No. 63168

918 Prince Street
Alexandria, VA 22314
Tel. (703) 519-9951
Fax (703) 519-9958